

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : John Wankmueller
Serial No. : 09/783,775 Examiner : Daniel Kesack
Filed : February 15, 2001 Group Art Unit: 3624
For : SYSTEM AND METHOD FOR CONDUCTING
ELECTRONIC COMMERCE WITH A REMOTE
WALLET SERVER

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

Applicant respectfully requests review of the repeated rejections of claim 1-6, 8 and 10 maintained the Final Office Action dated May 4, 2007 under 35 U.S.C. §112, first paragraph, as lacking written support; and variously under § 102(a) as anticipated by Paltenghe U.S. Patent Application Publication No. 2002/0004783 ("Paltenghe") or under 35 U.S.C. § 103(a) as being obvious from Paltenghe in view of Chaum et al. U.S. Patent Serial No. 6,434,238 ("Chaum"). A Notice of Appeal is being filed with this request.

Remarks

§ 112 rejection.

Applicant submits that a person of ordinary skill in the art will read the disputed limitation: “a non-chip card . . . issuer . . . legacy infrastructure . . .”, to mean an issuer (e.g., a bank) who issues a non-chip card (e.g., a magstripe card) and has infrastructure to support only legacy (i.e. non-chip) card transactions. The distinction of legacy and non-legacy relates to “chip” (i.e. modern or current) or “non-chip”(old). This is evident from the contextual use of the terms in claims 1 and 3 itself. Applicant submits that aforementioned meaning of the disputed limitation is readily understood by ordinary persons in the art based either on the plain English meaning of the limitation and/or their common knowledge of the payment card industry prior art.

While there is no in haec verba requirement, written support is also found in the Background Section of the specification (e.g., page 6 lines 3-15). The specification conveys with reasonable certainty to a person skilled in the art that the inventor had possession of the claimed subject matter based on the distinction of chip (new)and (non-chip (old, legacy) technologies at the time of filing.

§ 102(e) rejection.Claim 1

Applicant disputes that “irrespective of whether” is a negative limitation as incorrectly asserted in Office Action § 5. The limitation is equivalent to (and is readily understood to mean) “for both conditions,” or “condition-independent.” These are positive not negative attributes. Instead of the Examiner’s negative “not dependent” interpretation (see Office Action § 5, penultimate line page 2), the correct unbiased interpretation of the imitation is “independent.” Independence is a positive attribute.

The cited prior art does not show all the elements of claim 1.

Claim 3

The Office Action correctly notes that claim 3 describes a wallet server component in means plus function terminology. However, the Office Action incorrectly asserts that the function definition: “so that the transaction is accomplished . . . irrespective of . . .” does not limit the claimed wallet server.

Applicant notes that § 112, ¶ 6 allows description of claimed invention as a means for achieving a particular function. Claim 3 recites a means for the particular function of “conducting the transaction in manner that is independent of the card type (chip or non-chip).” The wallet server of claim 3 is limited to have the specific means for the particular function. Contrary to the Office Action’s assertion, this specific means deserves to be given a proper patentability weight

Further, contrary to the Office Action’s assertion, Paltenghe’s interface 6 is not a means that can perform the function of conducting the transaction in manner that is independent of the card type (chip or non-chip).” Interface 6, is according to Paltenghe, “between local function, 2 and the server 4.” Local function 2 is necessarily, according to Paltenghe, a smart card or chip device “virtual wallet”. Paltenghe’s server 4 only “supervise[s] a transaction between the virtual wallet and a merchant (See Paltenghe ¶¶ [0045], [0046] and [0071], and Fig. 1, etc.). Paltenghe does not show an interface or other means coupled to a non-chip card for conducting a transaction the non-chip card.

The cited prior art does not show all the elements of claim 3.


Applicant submits that in view of the previously presented Remarks, amended claims 1-10 are patentable over the cited references.

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Conclusion

This application is now in condition for allowance. Reconsideration and prompt allowance of which are requested. If there are any remaining issues to be resolved, applicant respectfully requests the Examiners to kindly contact the undersigned attorney by telephone for an interview.

Respectfully submitted,
BAKER BOTTS L.L.P.

A handwritten signature in black ink, appearing to read 'Manu J. Tejawani', is written over a horizontal line.

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